

REMARKS

In the Office Action dated April 18, 2005, claims 1-8 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by McKnight et al. (U.S. Patent No. 6,670,974). In addition, claims 9-13 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Seki et al. (U.S. Patent No. 6,570,597). Furthermore, claims 14-22 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable in view of McKnight et al., Seki et al. and/or Perroux et al. (U.S. Patent No. 6,459,441).

In response, Applicants have canceled claim 3 and amended the independent claims 1, 9 and 14 to more clearly distinguish the claimed invention from the cited references. In view of the amendments to the claims and the following remarks, Applicants respectfully request the allowance of the pending claims 1-2 and 6-22.

A. Patentability of Amended Independent Claims 1 and 9

The independent claim 1 was rejected under 35 U.S.C. §102(e) as allegedly being anticipated by McKnight et al. In response, Applicants have amended claim 1 to more clearly distinguish the claimed invention from the cited references. As amended, the independent claim 1 recites in part, *"the plurality of icon portions including a main body icon portion and a pair of wing icon portions, each of the wing icon portions being directly attached to the main body icon portion and protruding from the main body icon portion."*

The Office Action has equated the element 1240 in Fig. 12 of McKnight et al. with the claimed *"main body icon portion"* and elements 1204, 1206, 1208 and 1210 in the same figure with the claimed *"pair of wing icon portions"*. As clearly illustrated in Fig. 12 of McKnight et al., none of these alleged *"wing icon portions"* 1204, 1206, 1208 and 1210 are *"directly attached"* to the alleged *"main body icon portion"* 1240 and *"protruding from the main body icon portion,"* as recited in the amended claim 1. Thus, each limitation of the amended claim 1 is not disclosed in the cited reference of McKnight et al. As such, Applicants respectfully assert that the amended claim 1 is not anticipated by McKnight et al., and thus, should be allowed.

The independent claim 9 was rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Seki et al. In response, Applicants have amended claim 9 to more clearly distinguish the claimed invention from the cited references. As amended, the independent claim 9 recites in part *"the icon portions including a main body icon portion and a pair of wing icon portions, each of the wing icon portions being directly attached to the main body icon portion and protruding from the main body icon portion."*

The Office Action has referenced Figs. 2 and 5 of Seki et al. in support of the assertion that Seki et al. teaches the claimed limitation of the previously presented claim 9. In particular, the Office Action has equated the element 10 in Figs. 2 and 5 of Seki et al. with the claimed *"main body icon portion"* and presumably elements 12 and 14 in the same figures with the claimed *"pair of wing icon portions"*. As clearly illustrated in Figs. 2 and 5 of Seki et al., the elements 12 and 14 are NOT *"directly attached"* to the alleged *"main body icon portion"* 10 and *"protruding from the main body icon portion,"* as recited in the amended claim 9. Thus, each limitation of the amended claim 9 is not disclosed in the cited reference of Seki et al. As such, Applicants respectfully assert that the amended claim 9 is not anticipated by Seki et al., and thus, should be allowed.

B. Patentability of Amended Independent Claim 14

The independent claim 14 was rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Seki et al. in view of Perroux et al. In response, Applicants have amended claim 14 to more clearly distinguish the claimed invention from the cited references. As amended, the independent claim 14 recites in part *"the icon portions for each of the customized icons including a main body icon portion and a pair of wing icon portions, each of the wing icon portions being directly attached to the main body icon portion and protruding from the main body icon portion,"* which is similar to the amended claim 9. Thus, the above remarks with respect to the amended claim 9 are also applicable to the amended independent claim 14. As such, Applicants respectfully assert that the amended claim 14 is not obvious over Seki et al. in view of Perroux et al., and thus, should be allowed.

In addition, the cited reference of Perroux et al. does not teach the claimed limitation of “*determining the number of variations associated with the common characteristic*” (emphasis added), as recited in the amended claim 14. That is, Perroux et al. does not teach “*determining the number of*” operational domains or functions within the icon’s operational domain, which apparently have been equated with the claimed elements of “*variations associated with the common characteristic*”. Thus, the amended claim 14 cannot be obvious over Seki et al. in view of Perroux et al.

C. Patentability of Dependent Claim 13 and 18

The dependent claim 13 was rejected under 35 U.S.C. §102(c) as allegedly being anticipated by Seki et al., while the dependent claim 18 was rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Seki et al. in view of Perroux et al. The dependent claims 13 and 18 both recite “*wherein variably assigning is session based through the interface such that in one session a given visual trait may be assigned to a first characteristic and in a second session the given visual trait may be assigned to a second characteristic.*”

In rejecting these dependent claims 13 and 18, the Office Action stated “Seki et al. teaches the variably assigning to be in one session may have a visual trait assigned to a first characteristic and in a second session the visual trait may be assigned to a second characteristic (Figures 19 and Column 5, line 30 et seq.).” However, the referenced portion of Seki et al. does not appear to disclose the alleged teachings. In particular, the referenced portion does not teach “variably assigning” such that “*in one session a given visual trait may be assigned to a first characteristic and in a second session the (same) given visual trait may be assigned to a second characteristic,*” as recited in the dependent claims 13 and 18. As such, Applicants respectfully assert that the dependent claims 13 and 18 are neither anticipated by Seki et al. nor obviousness over Seki et al. in view of Perroux et al., and thus, the dependent claims should be allowed.

D. Patentability of Dependent Claim 20-22

The dependent claims 20-22 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable in view of McKnight et al., Seki et al. and/or Perroux et al. In rejecting these dependent claims 20-22, the Office Action has stated that "Applicant has not disclosed that wing icon portions shaped to resemble components of an ornamental Venetian glass candy provides an advantage, or is used for a particular purpose or solves a stated problem." However, these are not statutory requirements for patentability. The critical issue at hand is whether the claimed invention is obvious in view of the cited references.

To establish a *prima facie* case of obviousness, the following three basic criteria must be met, as set forth in MPEP 2143:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations."

Thus, to establish a *prima facie* case of obviousness for the dependent claims 20-22, there must be some suggestion or motivation to modify the teachings of McKnight et al., Seki et al. and/or Perroux et al. to derive the claimed invention.

The Office Action has failed to identify any valid suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the teachings of McKnight et al., Seki et al. and/or Perroux et al. to derive the claimed invention, as recited in the dependent claims 20-22. As such, Applicants respectfully assert that a *prima facie* case of obviousness for the dependent claims 20-22 has not been established, and thus, these claims should be allowed.

E. Patentability of Dependent Claim 2, 6-8, 10-12, 15-17 and 19

Each of the dependent claims 2, 6-8, 10-12, 15-17 and 19 depends on one of the amended independent claims 1, 9 and 14. As such, these dependent claims

include all the limitations of their respective base claims. Therefore, Applicants submit that these dependent claims are allowable for at least the same reasons as their respective base claims.

Applicants respectfully request reconsideration of the claims in view of the claim amendments and the remarks made herein. A notice of allowance is earnestly solicited.

Respectfully submitted,

Budrys et al.

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By: Thomas H. Ham
Thomas H. Ham
Registration No. 43,654
Telephone: (925) 249-1300